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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,074

03/16/2007

Peter Quirk

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EXAMINER

FONSECA, JESSIE T

ART UNIT

PAPER NUMBER

3633

MAIL DATE

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02/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,074	Applicant(s) QUIRK, PETER	
	Examiner JESSIE FONSECA	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly amended claims 22-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: In the instant case, the flashing of claims 1-20 and 22-25 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the claimed flashing could be used in a materially different process which does not require mounting flashing to mounted to separate first and second members, where the flashing of one member overlaps another. For example, the claimed flashing can be used as coping for a wall or can be used as cap/rail for a partition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 15: The claim is indefinite as the leg spacing is being defined by the member, which is not a positively claimed element.

Claim 15 is examined as best understood.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1-2, 4-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Weir (US 5,148,644).

With regard to claim 1: Weir discloses flashing (30') comprising an elongate body capable of overlying a member, and the flashing further comprising legs (A) extending for at least part of the body length and protruding from either side of the body (fig. 5)

The flexible flashing of Weir has a configuration prior to overlying the member whereby one or both legs is/are capable of being biased inwards towards a center line of the body and towards a respective member side when positioned thereat. Examiner notes the claim as amended defines the legs biasing inward when positioned on a member, but does not define the orientation of the legs prior to placement on a member.

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Depending on the width of member, the flashing of Weir would be capable of biasing inwards towards a center line of the body. Weir discloses the width between the legs (side portions) substantially corresponds to the width of the member to provide a form-fitting relationship (col. 1, line 67 - col. 2, line 4).

Note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

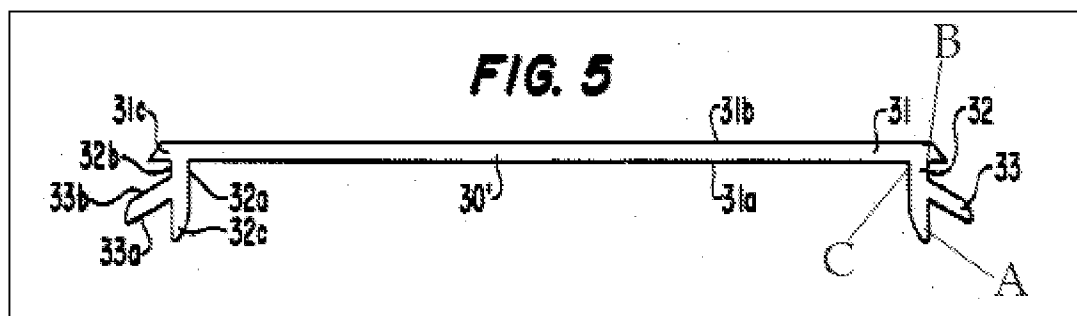


Fig. 5: Weir (US 5,148,644)

With regard to claim 2: Weir further discloses two legs (A) extending for the entire length of the body on opposing sides thereof (figs. 57).

With regard to claim 4: Weir further discloses wings (31C) extending laterally from the body beyond the legs (A) (figs. 5 & 7).

With regard to claim 5: Weir further discloses the wings (31C) extend for the entire length of the body on opposing sides thereof (figs. 5 & 7).

With regard to claim 6: Weir further discloses a line (B) provided along and adjacent to where each wing (33) is attached to the body.

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it is capable of being severed along that line.

With regard to claim 7: Weir further discloses the wings (31c) have an elongate rectangular shape on the bottom face of the wings and are respectively joined to the body along opposing elongate sides thereof (fig. 5).

With regard to claim 8: Weir further discloses each wing (33) tapers, from a relatively thicker section where it is connected to the body to a relatively thinner remote end (fig. 5).

With regard to claim 9: Weir further discloses a line (C) provided along and adjacent to where each leg is attached to the body.

Each leg of Weir is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line.

With regard to claim 10: Weir further discloses the body has an elongate rectangular shape (fig. 2).

With regard to claim 11: Weir further discloses the legs (A) have an elongate rectangular shape on the outer face and are joined to the body along opposing elongate sides thereof.

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With regard to claim 12: Weir further discloses each leg (A) tapers, from where it is connected to the body to a remote end.

With regard to claim 13: Weir further discloses flashing is formed from an elastomeric material (rubber) (col. 1, lines 52-56).

With regard to claim 14: Weir further discloses the member is a joist, beam, bearer, wall plate, rafter or batten. Note claims are directed to the flashing, the member is not a positively claimed element.

With regard to claim 15: The legs of Weir are capable of being spaced at approximately the width of the member (fig. 6).

With regard to claim 17: Weir discloses flashing (30') comprising an elongate body for overlying a member, and legs (A) protruding from either side of the body and extending for at least part of the body length (fig. 5).

Each leg of Weir is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line (B) of Weir is considered to read on the claim as it capable of severed along that line defined on the elongate body.

With regard to claim 18: Weir discloses flashing comprising an elongate body for overlying a member, and wings (31c) extending laterally from either side of the body and extending for at least part of the body length (figs. 5 & 7).

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite

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the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line defined on the elongate body.

With regard to claims 19-20: Weir discloses a line (B, C) provided along and adjacent to where each leg or wing is attached to the body.

Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line.

Claims 1-4 and 6-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sykes (WO 91/13221).

With regard to claim 1: Sykes discloses “flashing” (186b) comprising an elongate body capable of overlying a member, and the flashing further comprising legs (184) extending for at least part of the body length and protruding from either side of the body (fig. 8; pg. 11, lines 15-28)

The “flashing” of Weir has a configuration prior to overlying the member whereby one or both legs is/are capable of being biased inwards towards a center line of the body, and towards a respective member side when positioned thereat.

Note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

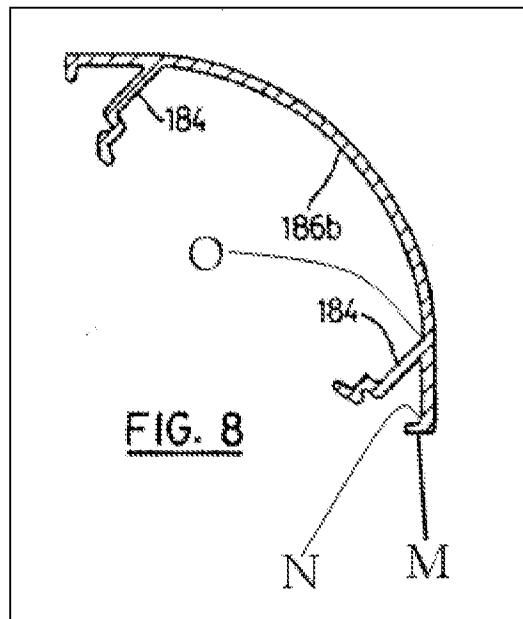


Fig. 8: Sykes (WO 91/13221)

With regard to claim 2: Sykes further discloses two legs (184) extending for the entire length of the body on opposing sides thereof (fig. 8).

With regard to claim 3: Sykes further discloses prior installation, the legs (184) on opposing sides of the body project generally towards each other (fig. 8).

With regard to claim 4: Sykes further discloses wings (M) extending laterally from the body beyond the legs (184) (fig. 8).

With regard to claim 6: Sykes further discloses a line (N) provided along and adjacent to where each wing (N) is attached to the body.

Each wing of Sykes is capable of being severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Sykes is considered to read on the claim as it is capable of being severed along that line.

With regard to claim 7: Sykes further discloses the wings (M) have an elongate rectangular shape and are respectively joined to the body along opposing elongate sides thereof (fig. 8).

With regard to claim 8: Sykes further discloses each wing (M) tapers, from a relatively thicker section where it is connected to the body to a relatively thinner remote end (rounded edge) (fig. 5).

With regard to claim 9: Sykes further discloses a line (O) provided along and adjacent to where each leg is attached to the body (fig. 8)

Each leg of Sykes is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of severed along that line.

With regard to claim 10: Sykes further discloses the body has an elongate rectangular shape from the perspective of top view (fig. 8) similar to that of applicant's.

With regard to claim 11: Sykes further discloses the legs (184) have an elongate rectangular shape on several faces and are joined to the body along opposing elongate sides thereof.

With regard to claim 12: Sykes further discloses each leg (184) tapers (rounded edge), from where it is connected to the body to a remote end.

With regard to claim 14: The "flashing" of Sykes is capable of being disposed on a joist, beam, bearer, wall plate, rafter or batten. Note claims are directed to the flashing, the member is not a positively claimed element.

With regard to claim 15: Sykes further discloses the legs protrude from the body a distance from one another, the distance capable of being spaced at distance approximately equal to a width of the member (fig. 6).

With regard to claim 16: Sykes further discloses the body is provided with a contoured profile, with the legs (184) extending inwardly from a concave surface of the body. The body of Sykes is capable of assuming a generally flat configuration when the “flashing” is located on a member as it is made of a thin resilient material (pg. 11, lines 15-28).

With regard to claim 17: Sykes discloses “flashing” (186b) comprising an elongate body for overlying a member, and legs (184) protruding from either side of the body and extending for at least part of the body length (fig. 8).

Each leg of Sykes is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line (O) of Sykes is considered to read on the claim as it capable of being severed along that line.

With regard to claim 18: Sykes discloses flashing comprising an elongate body for overlying a member, and wings (M) extending laterally from either side of the body and extending for at least part of the body length (figs. 8).

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line (N) of Sykes is considered to read on the claim as it capable of being severed along that line.

With regard to claims 19-20: Weir discloses a line (N, O) provided along and adjacent to where each leg or wing is attached to the body.

Note the claim does not recite the structure of the line of severance. Accordingly, the line of Sykes is considered to read on the claim as it capable of being severed along that line.

Response to Arguments

Applicant's arguments filed 10/22/09 have been fully considered but they are not persuasive.

Applicant argues that amended claim 15 now recites the leg spacing is defined by a distance as opposed to the member.

Examiner submits the claim still recites the distance of the legs in terms of the member. Examiner suggests adding intended use language to make it clear applicant is not defining the distance in relation to the member.

Applicant argues the side portions of Weir and Sykes are not biased towards a center line of the main body portion.

Examiner notes the claims recites the legs biases towards a center line of the body when positioned on a member. It is submitted that both Weir and Sykes are capable of performing applicant's intended use. Depending on the width of member (not positively recited), the legs are capable of biasing towards the center of the body.

Applicant further argues that the cover of Sykes does not overly the member as recited in claim 1.

As noted in the prior Office Action, the member is not a positively claimed element. Accordingly, Sykes meets the flashing structure of claim 1 and would be capable of performing applicant's intended use.

Applicant further argues that both Weir and Sykes fails to disclose or suggest a line of severance.

As noted in the prior office action, the claims does not recite the structure of the line of severance. Accordingly, any line capable of be severed would meet the claim. Examiner suggests further defining the structure of the line of severance as shown in the figures.

The previous rejection of claims 22-25 under 112 2nd paragraph has been withdrawn in view of the amendment filed 10/22/09.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited is directed to coverings for various building elements/members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on (571)272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. F./
Examiner, Art Unit 3633

/Robert J Canfield/
Primary Examiner, Art Unit 3635